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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,800	12/09/2003	Raymond F. Watts	2003L008	4327
7590 Infineum USA L.P. Law Department 1900 East Linden Avenue P. O. Box 710 Linden, NJ 07036-0710		07/12/2007	EXAMINER GOLOBOY, JAMES C	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 07/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/731,800

Applicant(s)

WATTS ET AL.

Examiner

James Goloboy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/4/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/4/07 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 has been amended to exclude R groups containing a primary amine. As discussed in the advisory action mailed 4/30/07, there is no support for this new limitation in the application as originally filed. While numerous R groups not containing a primary amine are disclosed on page 7 of the specification, the mere absence of a positive recitation is not basis for an exclusion. There is no support

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for excluding only those R groups containing a primary amine. The examiner recommends that the claim be amended to limit the R groups to those disclosed on page 7 of the specification. If the new limitation is removed, the rejections set forth in the prior office actions would continue to apply.

***Claim Rejections - 35 USC § 102***

4. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sung (U.S. Pat. No. 4,505,835).

In column 1 lines 6-9 Sung teaches a lubricant composition containing a friction modifier which is a reaction product of a maleic anhydride and an amine. In column 8 lines 46-53, Sung provides an example where the amine is N-oleyl-1,3-propane diamine, which contains 21 carbon atoms, falling within the ranges recited in claims 1(c) and 3, and does not contain a primary amine in the R group. The use of maleic anhydride as a reactant meets the limitations of claims 1(c), 2, and 6, and Sung teaches in column 6 lines 21-27 that the friction modifier is used in concentrations falling within the range recited in claim 4. In columns 6-8 Sung teaches that the composition can comprise other additives, including a detergent (column 6 line 35 through column 7 line 39), and other convention additives (column 7 line 60 through column 8 line 3), which meet the performance additive package limitation of claim 1(b). While Sung discloses the composition as particularly useful in marine diesel engines, it is the examiner's position that the composition of Sung would also function as a power transmission fluid, as it contains a similar base oil and additives. Case law holds

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that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Claim Rejections - 35 USC § 103***

5. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sung in view of Ohtani (U.S. Pat. No. 5,344,579).

The discussions of Sung in paragraph 4 above and Ohtani in paragraph 7 in the office action mailed 8/15/06 are incorporated here by reference. Ohtani discloses in column 1 lines 21 and 30-31 the utility of lubricants containing a friction modifier in automatic transmission and other power transmission devices, as recited in claims 7-8. It would have been obvious to one of ordinary skill in the art to include the fluid disclosed by Sung in within an automatic transmission or other power transmission device, as taught by Ohtani, for the purpose of extending the useful life of the transmission device, as disclosed in column 1 line 21 of Ohtani.

### ***Response to Arguments***

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6. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection. However, as noted in paragraph 3 above, if the new limitation were to be removed from claim 1, the rejections set forth in the prior office actions would continue to apply. The examiner's positions regarding those rejections are adequately set forth in the office actions mailed 8/15/06 and 2/23/07.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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